

Notice of Allowability

Application No.

10/501,196

Applicant(s)

SAMUELSON ET AL.

Examiner

Art Unit

Charles L. Patterson, Jr.

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed 7/9/04 and 11/8/04.
2. ☒ The allowed claim(s) is/are 1-17.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


CHARLES L. PATTERSON, JR.
PRIMARY EXAMINER

GROUP 1800

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EXAMINER'S AMENDMENT AND REASONS FOR ALLOWANCE

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Harriet Strimpel on September 19, 2005.

The application has been amended as follows:

On page 1, between the title and the "Background Of The Invention", insert the following;

--This application is a § 371 application of international application number PCT/US03/00542 filed 09 January 2003, which claims priority from U.S. provisional application number 60/347,403 filed 01 January 2002, herein incorporated by reference.--;

At the end of page 7, insert the following:

--Figure 5 shows an agarose gel where

U = uncut substrate pXba,

NotI = pXba cut with NotI and

44-2A = pXba cut by mutant 44-2A. (Star: 16kb fragment cut into 9kb and 7kb fragment).

Figure 6 shows a map of pAGR3.

Figure 7 shows a map of pAII17.--;

In claim 4, line 7, delete "BRS" and insert therefor --ribozyme binding site (BRS)--;

The following is an examiner's statement of reasons for allowance:

The examiner has been unable to find anything in the prior art that would anticipate the claimed invention or make it obvious. The use of non-cognate methylases to change the recognition site of restriction enzymes appears to be novel. There was some question raised in reading the specification as to the enablement of the invention in that "ER2502" and "ER1992" were disclosed as containing different plasmids with different methylase genes. However, after reading the specification more closely and reading U.S. Patent 5,498,535, it was deduced that "ER1992" was a particular indicator strains and "ER2502" is a genetic selector host and each can contain different plasmids. Support for the added description to Figures 6-7 is on page 29.

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Janulaitus, et al., (N) and Samuelson, et al. (U) were contained in the PCT search report and included with original application filed 7/9/04 but not on the PTO-1449. Therefore they are listed on the enclosed PTO-892. Fomenkow, et al. (A) and Nelson, et al. (V) is cited as of interest.

The instant claims are deemed to define over Janulaitus, et al (B) in that the claims require selection of the mutated endonuclease gene "in a population of prokaryotic host cells expressing one or more non-cognate DNA methyltransferase, wherein the genetic selection selects for viable cells in the population" and the method of Janulaitus, et al. involves digestion with another endonuclease having a related recognition sequence. The patent also does not select for viable cells.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
September 20, 2005